

REMARKS

After entry of this amendment, claims 1, 7-11, 32, 36, and 39 as presented herein are under consideration. Claims 1, 7, 8, 9, 32, and 36 are amended without any intention of disclaiming equivalents thereof; claims 33, 34, 37, and 38 are cancelled without prejudice and without any intention of abandoning the subject matter thereof; and new claim 39 is added. Support for the amendments and new claim is found in the specification, for example, on page 2, line 11 to page 4, line 2; on page 5, line 14 to page 6, line 4; on page 8, line 23 to page 9, line 20; on page 12, lines 16-20; on page 16 line 25 to page 17 line 4; on page 18 line 18 to page 19 line 9; and in Figure 2. Applicants respectfully submit that no new matter is added by these amendments. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims.

Objection to Specification

Applicants acknowledge the objection in the Office Action to the incorporation by reference of documents in the specification and that documents cited in the specification have not been considered with effect towards fulfilling the written description and enablement requirement. However, it does not appear as if any action is required on the part of the Applicants. Nevertheless, Applicants do not acquiesce to or agree with the Office's statement that the documents cited in the specification are not properly incorporated by reference, and Applicants reserve the opportunity to further address the issue should it become relevant to the claims pending after entry of this paper. As described above, these claims are supported by the specification as filed. To the extent a specific document is deemed improperly incorporated with regard to claims pending after entry of this paper, Applicants respectfully request that the Office identify the document and state the reason that it is deemed an improper incorporation. To the extent the Office requires anything further, Applicants welcome the opportunity to discuss the matter with the Office.

Rejections under 35 U.S.C. § 112

A. 35 U.S.C. § 112, First paragraph - Written Description

Claims 1, 7-11, 32-34, and 36-38 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, were in possession of the claimed invention. While not acquiescing to the rejection, Applicants have amended independent claims 1 and 32 and have cancelled claims 33, 34, 37, and 38, and, accordingly, this rejection is moot.

To the extent that a similar rejection based on an alleged lack of written description would apply to the claims pending after entry of this paper, Applicants have considered the remarks in the Office Action but respectfully submit that the claims as amended do not lack written description. For example, one example provided in the specification (pages 18-19), accompanied by a drawing (Figure 2), depicts one embodiment of the invention, as well as how to isolate a target molecule. Moreover, in the specification, for example on page 11, lines 5-14, Applicants teach the factors to consider when selecting the stringency of a hybridization reaction and teach empirically testing such conditions.

In view of the foregoing, Applicants respectfully traverse the rejection, as it is now moot, and respectfully request that this rejection under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

B. 35 U.S.C. § 112, First paragraph - Enablement

Claims 1, 7-11, 32-34, and 36-38 presently stand rejected under 35 U.S.C. § 112, first paragraph. The Office Action alleges that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. Without acquiescing to the rejection, in view of the amendments to the independent claims and the cancellation of claims 33, 34, 37, and 38, the rejection is moot. However, to the extent this rejection is maintained against the claims pending

after entry of this paper, Applicants respectfully traverse the rejection in view of the following remarks.

The Office Action contends that the applicants were not in possession of the invention at the time of filing, and accordingly could not have enabled that which they did not possess. The enablement requirement, however, is separate and distinct from the written description requirement. Therefore, the fact that the Office alleges the claims lack written support does not necessarily mean that they are not enabled. As such, a rejection on this basis is improper. See MPEP § 2164.

Applicants also submit that the specification provides a comprehensive description of how to test, make, and use the claimed invention. The specification provides an example of the invention, at least on pages 18-19 and in Figure 2. In this regard, Applicants note Examples 3 and 4. Even assuming arguendo that U.S. Publication No. 2003/0133846 and U.S. Publication No. 2002/0090641 support the Office's position that there are art recognized problems regarding elution (a position to which the Applicants do not acquiesce), Example 3 specifically describes how to capture and elute a target and how to determine the optimal temperature for capture and elution, and Example 4 provides an example of specific elution conditions as well as an example of how to determine the conditions under which elution should take place.

In view of the foregoing, Applicants respectfully traverse the rejection, as it is now moot, and respectfully request that this rejection under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

C. 35 U.S.C. § 112, Second paragraph

Claims 1, 7-11, 32-34, and 36-38 presently stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Amended independent claims 1 and 32 more particularly define a purification unit, as well as how the elements of a purification unit (including those elements listed in the Office Action) are interrelated. Applicants also

respectfully submit that amended independent claims 1 and 32 do not omit an essential element insofar as a means to effect separation/purification of the nucleic acids of interest is not an essential element. The device itself is claimed and this device is described separately from, for example, means to provide an electric motive force. See e.g., Specification page 10, lines 3-5. As such, Applicants respectfully submit that all of the elements of amended independent claims 1 and 32 are interrelated.

Accordingly, because the elements of amended independent claims 1 and 32 are interrelated, and because claims 33, 34, 37, and 38 are cancelled without prejudice, rendering their rejection moot, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 7-11, 32-34, and 36-38.

CONCLUSION

On the basis of the foregoing amendments and remarks, Applicants submit that claims 1, 7-11, 32, 36, 39 are in condition for allowance and request early and favorable action.

Respectfully submitted,



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